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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/717,404

11/19/2003

Thomas M. Vanasse

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7272

27777 7590 06/26/2008  
PHILIP S. JOHNSON  
JOHNSON & JOHNSON  
ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

ARAJ, MICHAEL J

ART UNIT

PAPER NUMBER

3733

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/717,404	<b>Applicant(s)</b> VANASSE ET AL.	
	<b>Examiner</b> MICHAEL J. ARAJ	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3-6,8,9,12-14,16,17 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,10,11,15,18,19 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 1, 2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

Claims recites the limitation "a region that is cut-out of the contact area" The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,2,7,10,11,15,18,19 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1, 10, 18 and 23 recites the limitation "a region that is a cut-out of the contact area". There appears to be a lack of support or clarity of the word 'cut-out' in the specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7, 10, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolanos et al. (U.S. Patent No. 5,471,756) in view of Kolb (U.S. Patent No. 6,926,741).

Bolanos et al. disclose an instrument (110) having an elongated central portion (that is generally cylindrical-126) defining opposed first and second ends (adjacent to the sizing number 129), a first contact portion (133) having a contact area and extending from the first end of said elongated central portion, a second contact portion (143) having a contact area extending from the second end of said elongated central portion and a relief area defined on the first and second contact portions. The relief areas for providing clearance between the instrument and the medullary canal are considered to be the surfaces 134 and 144. At least one of said first contact portions and said second contact portion comprises a plurality of contact areas. The multiple areas on the contact portions (133 and 144) are considered to be more than one depending on the area defined. With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Bolanos et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459

(CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Bolanos et al. disclose the claimed invention except for the relief area having a region that is cut-out of the contact area. Kolb discloses a cavity ('cut-out') 50 that is used in conjunction with another instrument (rod) to be able to centralize the implant and provide accuracy and consistency for implantation. It would have been obvious to one skilled in the art at the time the invention was made to have created the device of Bolanos et al. with a cut-out area in view of Kolb, in order to add consistency and accuracy to the measuring of the canal.

Claims 18, 19, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikhail (U.S. Patent No. 5,314,493) in view of Bolanos et al. (U.S. Patent No. 5,47,756) further in view of Kolb (U.S. Patent No. 6,926,741).

Mikhail discloses a method for performing joint arthroplasty comprising resecting a long bone, preparing the medullary canal of a long bone, inserting instruments into the canal, providing a plurality of centralizers for implanting into the medullary canal, determining the appropriateness of the instruments and providing a stem and implanting it into the canal of a long bone. Mikhail discloses the claimed invention except for the use of the measuring instrument as claimed in claim 1. As stated above, Bolanos et al.

Art Unit: 3733

disclose a measuring instrument for providing a fast and simple technique for measurement of a canal (abstract). It would have been obvious to one skilled in the art at the time the invention was used the method of Mikhail with the measurement device of Bolanos et al., in order to create a faster and less complicated method for joint arthroplasty.

The combination of Mikhail and Bolanos et al. disclose the claimed invention except for the relief area having a region that is cut-out of the contact area. Kolb discloses a cavity ('cut-out') 50 that is used in conjunction with another instrument (rod) to be able to centralize the implant and provide accuracy and consistency for implantation. It would have been obvious to one skilled in the art at the time the invention was made to have created the invention of Mikhail and Bolanos et al. with a cut-out area in view of Kolb, in order to add consistency and accuracy to the measuring of the canal.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1,2,7,10,11,15,18,19 and 23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. ARAJ whose telephone number is (571)272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Araj/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733